



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,848	12/13/2001	Bruno Colin	BONN-070	1212

7590

10/06/2004

James C Lydon
Suite 100
100 Daingerfield Road
Alexandria, VA 22314

EXAMINER

KIM, YOUNG J

ART UNIT	PAPER NUMBER
----------	--------------

1637

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/009,848	Applicant(s) COLIN ET AL.	
	Examiner Young J. Kim	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>December 13, 2001</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

Applicants' claim to prior-filed application, FR 99/08117, filed on June 22, 1999 is acknowledged.

Applicant cannot rely upon the foreign priority papers to overcome the below rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Information Disclosure Statement

The IDS received on December 13, 2001 is acknowledged. A signed copy of its PTO-1449 is attached hereto.

Preliminary Remark

The preliminary amendment received on June 30, 2004, canceling claims 1-20, amending claims 21, 26-30, 32, and 36; and adding new claims 40-45 is acknowledged.

Claims 21-45 are pending and are under prosecution therefore.

Specification

The specification is objected to because on page 7, line 19, the specification, while referring to Figure 1, discloses that "the sample leaves the outlet (65)," but Figure 1 does not describe the element 65.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1637

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 (and its dependent claims 22-45) are indefinite for reciting the phrase, “(A, B, C, D) because without a conjunction between the “C” and the “D” it becomes indefinite whether the elements recited in the brackets are a required limitation or an example. Further, the phrase, “between several levels” is indefinite because it is unclear how the different levels are identified (*i.e.*, vertically, horizontally).

Regarding claims 21-45, the word "means" is preceded by the word(s) "which can be deformed...and lead to direct or indirect closing of said channel" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, the specification does not recite what such means are, rendering said means indefinite.

Claims 22-24 are indefinite for reciting the phrase, “the fluids are allowed to flow between the initial compartment and the receiving compartment at the same time in all the reaction lines,” because it is unclear whether the phrase means that the fluids are allowed to flow between the two compartments simultaneously *or* the flow between the two compartments (from initial compartment to the receiving compartment) are achieved simultaneously among all the reaction lines.

Claims 23 and 24 are indefinite for reciting the phrase, “substantially straight,” because the term substantially is not defined to determine what is considered to be a “substantially” straight line.

Art Unit: 1637

Claim 23 is indefinite for reciting the phrase, “with all the valves being equidistant” because the phrase lacks a reference point from which the equidistance is measured.”

Claim 26 is indefinite for reciting the phrase, “each compartment...contains a means of keeping a tablet in position, with said means at *a distance* from a bottom of said compartment” because it is unclear how the compartment can have more than one bottom (as denoted by the use of the phrase, ‘a bottom’), as well as what length is covered by the limitation, “a distance.”

Claim 27 is indefinite for reciting the phrase, “substantially isosceles triangle,” because a triangle is either scalene, isosceles, or equilateral triangle. A triangle cannot be substantially isosceles without becoming a scalene triangle. Therefore, the term, “substantially isosceles” renders the claim confusing how a triangle can still be considered a substantially isosceles without being a scalene triangle.

Claim 28 is indefinite because the claim recites that stanchions “define the limits of a tablet,” but fails to recite what aspects of the tablet is limited, rendering the claim indefinite in its metes and bounds.

Claim 29 is indefinite for reciting the phrase, “a regular distance” because it becomes unclear what distance is considered to be “regular” versus “irregular.”

Claims 30 and 31 are indefinite for reciting the phrase, “substantially perpendicular,” because absent a specific definition (not an exemplary definition), it becomes indefinite as to what range of degrees lesser than or in excess of 90° is embraced by the limitation, “substantially perpendicular.”

Claim 32 is indefinite for reciting the step, “sending each sample or aliquot of sample through for testing purpose,” because it is unclear whether the sample or the aliquot of the

Art Unit: 1637

sample is being sent to a level where, "at least one processing" is conducted, thus tested within the card or the sample is being "sent" to another device.

Claim 33 recites the term, "the analysis," but such antecedent basis is not found. Further it is unclear how where the recited analyses are conducted with respect to the card that is employed.

Claim 44 is indefinite because it recites, "[t]he test card of claim 29," but claim 29 is drawn to a device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-26, 29-41, and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Southgate et al. (U.S. Patent No. 5,863,801, issued January 26, 1999).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Applicants are also advised that were certified translation of the foreign priority papers be filed, the instant rejection would be maintained under 35 U.S.C. 102(e), as having an earlier filing date of June 14, 1996.

Southgate et al. disclose a cassette and a method of using the cassette, wherein said cassette has a dimension of 4 inches by 6 inches, with 0.2 inches thickness comprising at least two reaction lines running parallel to each other (column 21, lines 8-13; Figure 9), each lines comprising at least two valves (column 21, line 38 and 40), the valves of which are disclosed as being operated by an actuator (column 2, lines 48-52). The cassette of Southgate et al., as evidenced by Figure 9, comprises different levels conducting different stages of reactions (column 21). While Southgate et al. identifies their device as a cassette while the instant claim identifies the device as a card, the term, "card" in the preamble carries no patentable weight as all of the limitations which defines said card is anticipated by Southgate et al. Additionally, even if, *arguendo*, that the card does carry an implied limitation of size, the cassette of Southgate et al. comprises the dimensions 4 by 6 inches having 0.2 inches of depth, thus arguably a, "card."

All of the valves appear to be equidistant in their placing with respect to top of the device (Figure 9).

The substantially straight reaction line of Southgate et al. is, as evidenced by Figure 9, perpendicular to the bottom of the cassette (thus, one side of the card).

The buffer supply is disclosed as being located on the opposite end (thus opposite side) of where the reaction site (Figure 9, element 1108 and element 1116).

Each compartment of the device of Southgate et al. comprises different buffers, such as wash buffers, TE buffers (Figure 9, element 1116 and element 1117).

Southgate et al. disclose a device which operates the cassette for conducting nucleic acid extraction reactions (column 3, lines 48-58).

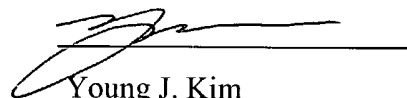
Therefore, Southgate et al. anticipate the invention as claimed.

Conclusion

No claims are allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner can normally be reached from 8:30 a.m. to 6:00 p.m. Monday through Thursday. If attempts to reach the Examiner by telephone are unsuccessful, the Primary Examiner in charge of the prosecution, Dr. Kenneth Horlick, can be reached at (571) 272-0784. If the attempts to reach the above Examiners are unsuccessful, the Examiner's supervisor, Gary Benzion, can be reached at (571) 272-0782. Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (703) 872-9306. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.



Young J. Kim
Patent Examiner
Art Unit 1637
9/20/04

**YOUNG J. KIM
PATENT EXAMINER**

yjk